

REMARKS:

Claims 1-18 and 20-32 are pending without further amendment.

Applicants have carefully considered the Examiner's Action of October 13, 2006, and the references cited therein. The following is a brief summary of the Action.

Claims 1-32 were rejected under 35 U.S.C. 112, first paragraph, as being based on a disclosure that is not enabling. Claims 1-32 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1-5, 7, 8, 11-13, 16-18 and 32 were rejected under 35 U.S.C. 102(e) as being anticipated by Borrero (U.S. Patent No. 6,799,695).

Claim 6 was rejected under 35 U.S.C. 103(a) as being unpatentable over Borrero in view of Yamada (U.S. Patent No. 5,704,471). Claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over Borrero in view of Pehr (U.S. Patent No. 6,349,849).

Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Borrero in view of Pehr and further in view of Amundson et al (U.S. Patent No. 6,604,651). Claims 14, 15, 20, 21, 23, 24 and 27-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Borrero in view of Peebles (U.S. Patent No. 3,343,716). Claim 22 was rejected under 35 U.S.C. 103(a) as being unpatentable over Borrero in view of Peebles and further in view of Yamada. Claim 25 was rejected under 35 U.S.C. 103(a) as being unpatentable over Borrero in view of Peebles and further in view of Pehr.

Claim 26 was rejected under 35 U.S.C. 103(a) as being unpatentable over Borrero in view of Peebles and Pehr as applied to claim 25, and further in view of Amundson et al.

Claim 31 was rejected under 35 U.S.C. 103(a) as being unpatentable over Peebles in view of Borrero.

As to the rejection of claims 1-32 under the first paragraph of Section 112, paragraph 3 on page 4 of the Final Office Action states (emphasis in original, citations omitted):

Claims 1-32 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The applicant discloses, "said body configured with an exterior surface that is **ergonomically shaped to generally conform** to being carried and held in one hand of the user" which seems to be some type of size range critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. This size range is not disclosed within the specification.

Applicants hereby traverse this rejection of claims 1-32 under the first paragraph of Section 112. The disclosure must be enabling to the person of ordinary skill. As to informing the person of ordinary skill how to make and use "said body configured with an exterior surface that is **ergonomically shaped to generally conform** to being carried and held in one hand of the user," it is said that a picture is worth a thousand words. Per page 4, lines 6 – 23, embodiments of the claimed device are illustrated in Figs. 1A, 1B, 1C, 1D, 2, 3, 4A, 4B. See also support for the claimed feature at issue at page 5, lines 19 – 20, 25 – 25, and page 8, lines 10 - 13. Moreover, users are female human beings. Respectfully, knowledge of the range of sizes of female human hands is within the level of ordinary skill. In view of the foregoing, the mere reference to "generally conform to being carried in one hand of the user * * * " suffices to enable the person of ordinary skill to practice the claimed invention.

Claims 1-32 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Paragraph 5 on page 4 of the Final Action questioned "what is an ergonomically shaped exterior surface" and what does "generally conform" mean? The

dictionary defines ergonomically as “designed and arranged to interact with people most efficiently and safely.” Hence, applicants’ portable carrying case that has a body that has “an exterior surface that is ergonomically shaped” means that the exterior surface of the body is designed and arranged to interact with people most efficiently and safely. As noted above, Applicants gave additional meaning to these phrases by virtue of the embodiments illustrated in Figs. 1A, 1B, 1C, 1D, 2, 3, 4A, 4B and the descriptions at page 4, lines 6–23, page 5, lines 19–20, 25–25, and page 8, lines 10-13.

For the reasons explained above, applicants respectfully submit that claims 1-18 and 20-32 are patentable under 35 U.S.C. 112, first and second paragraphs.

For the reasons explained below, applicants respectfully traverse the rejection of claims 1-5, 7, 8, 11-13, 16-18, and 32 under 35 U.S.C. 102(e) as being anticipated by Borrero.

Lines 1 - 2 of paragraph 6 on page 5 of the Final Office Action state:

Regarding claim 1, Borrero discloses a portable carrying case for personal care absorbent articles,

However, this statement inaccurately describes what is disclosed in Borrero and ignores the express disclosure of Borrero. As the following passages from Borrero make clear, the Borrero dispensing device is not intended or configured to be a portable carrying case. To the contrary, the Borrero dispensing device is intended and configured to be mounted or attached to a wall or on a flat surface such as a table or a shelf. The Borrero dispensing device is therefore a fixture. Column 1, lines 19 - 21 of Borrero states (emphasis added):

It is further desirable to provide a sanitary napkin dispensing device that may be selectively **mounted to a wall or surface of choice**.

Column 1, lines 29 - 31 of Borrero states (emphasis added):

Another object of the present invention is to provide a sanitary napkin dispensing device that may be selectively **mounted to a convenient location** of .

Column 1, lines 58 - 60 of Borrero states (emphasis added):

The main housing element is further **furnished with wall mounting brackets** located at the top most ends of the sides of the sanitary napkin dispensing device.

Column 2, lines 33 - 35 of Borrero states (emphasis added):

An individual having a sanitary napkin dispensing device selectively **attached to a wall or other convenient location** may access and remove a sanitary napkin for use.

Column 3, lines 29 - 31 of Borrero states (emphasis added):

Also shown is the sanitary napkin dispensing device selectively **mounted waist high on one of the walls** that comprise the private vicinity.

Column 4, lines 56 - 58 of Borrero states (emphasis added):

The device 10 is shown in FIG. 1. As shown in FIGS. 1-9, the device 10 encloses sanitary napkins 12, supports a disposal bag 14, and can be **mounted on a wall 16**.

Column 5, line 60 – column 6, line 5 of Borrero states (emphasis added):

As shown in FIG. 1, it is often desirable to **mount the device 10 on a wall 16**. Mounting brackets 54 are provided for this purpose, and are attached to the housing left side 24 and right side 26. In other embodiments (not shown), other attachment means are provided such as housing rear side 30 slots, housing rear side screw holes, and the like, all in accordance with the present invention, and as determined by the intended end use for the overall device, as will occur to those of skill in the art upon review of the present disclosure.

Column 6, lines 6 - 9 of Borrero states (emphasis added):

In another embodiment, such as shown in FIG. 10, the hooks 54 are not present, or do not extend below the housing bottom side 28, **allowing the bottom side to serve as a base for a freestanding utilization of the device 10.**

In contrast to the device 10 of Borrero, the case described in each of independent claims 1 and 20 is a “portable carrying case.”

Claims 1 and 20 require a carrying case that has a “body configured with an exterior surface that is ergonomically shaped to generally conform to being carried and held in one hand of the user while the user’s other hand removes an article from the internal enclosure.” The Borrero device 10 is not configured to be carried and held in one hand of the user while the user’s other hand removes an article from the internal enclosure of the device. Instead of being configured to be carried and held in one hand of the user, the Borrero device 10 is configured to be carried by a wall or by a shelf or table.

Claims 1 and 20 require Applicants’ portable carrying case to include a body that has “an exterior surface that is ergonomically shaped.” The exterior surface of the Borrero device 10 has numerous flat surfaces, sharp edges and pointed corners that inherently fail to interact with people most efficiently and safely. Instead, the exterior surface of the Borrero device 10 is configured to interact with a wall or a shelf or a table. Accordingly, unlike Applicants’ portable carrying case, the Borrero device 10 lacks a body that has “an exterior surface that is ergonomically shaped.”

Claims 1 and 20 require Applicants’ portable carrying case to include “a manual push structure defined in said body generally opposite from said opening.” The Borrero opening 48 is defined generally opposite Borrero rear wall 30. Lines 1 – 5 of the last

bullet point of paragraph 6 on pages 5-6 of the Final Office Action state that Borrero discloses:

a manual push structure (32 and 42) defined in said body generally opposite from said opening (48), said push structure (32 and 42) configured to allow a user to push on the bottommost one of said stacked absorbent articles (12) so as to move the uppermost one of said stack of absorbent articles (12) towards said opening (48) for grasping retrieval by the user.

However, the foregoing statement inaccurately describes what is disclosed in Borrero and ignores the express disclosure of Borrero. Taking the Final Action's designation of the manual push structure as Borrero elements 32 and 42, then under no reasonable interpretation can the Borrero top lid 32 or the Borrero spring 42 be said to be "defined in" Borrero's rear wall 30, which is opposite from said opening 48. This becomes apparent from a viewing of Fig. 7, which is the drawing that appears on the front page of the Borrero patent. Borrero top lid 32 is connected to Borrero back wall 30 by a hinge 34, but Borrero top lid 32 is not "defined in" Borrero's rear wall 30. Borrero spring 42 is connected to Borrero top lid 32, but Borrero spring 42 is not "defined in" Borrero's rear wall 30. Thus, Borrero fails to disclose a manual push structure (32 and 42) defined in said body in the appropriate relationship to the opening.

Lines 3 – 8 on page 6 of the Final Office Action state (emphasis added):

Regarding claim 2, Borrero discloses an absorbent article carrying case as in claim 1, and further discloses a body comprising a multi-sided structure (10) including a first wall and a second wall disposed opposite said first wall, said opening (48) defined in said first wall (22) and **said push structure (32 and 42) defined in said second wall (30) [the push structure defined in the second wall may be positioned to be opposite the first wall].**

However, as noted already above, Borrero fails to disclose a manual “push structure (32 and 42) defined in said second wall (30).”

In the square-bracketed portion quoted above, the Final Action asserts that “the push structure [32 and 42] defined in the second wall [30] may be positioned to be opposite the first wall [22].” However, such a statement is false. To so position the push structure [32 and 42] would prevent such push structure [32 and 42] from satisfying the remaining requirements of claims 1 and 20 imposed on the push structure [32 and 42]. For claims 1 and 20 require such push structure [32 and 42] to be “configured to allow a user to push on the bottommost one of said stacked absorbent articles so as to move the uppermost one of said stack of absorbent articles towards said opening for grasping and retrieval by the user.”

Any one of the above deficiencies in Borrero prevents Borrero from anticipating claims 1 and 20 and the claims dependent on claims 1 and 20.

Similarly, as to claims 3 and 4, Borrero fails to disclose any push structure in Borrero’s back wall 30.

Claim 8 requires an “access opening having a restricted size so as to prevent removal of said bottommost article through said access opening.” As to claim 8, page 3, lines 15-16 of the final Office Action contends that:

When the lid is closed the opening is restricted and prevents removal of said bottommost article through said access opening.

However, claim 8 calls for the size of the opening to be restricted, not obstructed or closed. Restricted is different from having the opening closed wherein there is no opening.

As to claim 8, Borrero fails to disclose an access opening having a restricted size so as to prevent removal of said bottommost article through said access opening.

When the Borrero lid 32 is opened, that opening is where the articles are loaded into the housing, and thus that opening fails to prevent removal of the bottommost article through the access opening. For the Final Action to take the position that the closed lid satisfies the claim 8 limitation of “said access opening having a restricted size so as to prevent removal of said bottommost article through said access opening” is a position at odds with the plain meaning of the words to the person of ordinary skill. If the lid is closed, a closed lid does not restrict the size of the opening. There must be an opening for the opening to have size. A closed lid eliminates the opening. Opening and closing the lid does not affect the size of the opening. Opening and closing the lid affects the user’s access to the opening, whatever the opening’s size.

Moreover, the Final Action’s citation of Borrero in this manner necessitates turning the ordinary notions of upper and lower on their head. To the person of ordinary skill, and to human beings in general, notions of uppermost and bottommost are tied to the direction of the force of gravity. The Borrero opening 48 is intended in use to be lower than the Borrero top lid 32.

Applicants therefore respectfully submit that claims 1-5, 7, 8, 11-13, 16-18 and 32, as presented herein, are patentable under 35 U.S.C. § 102(e) over Borrero.

For the reasons explained below, applicants respectfully traverse the rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over Borrero in view of Yamada.

Yamada fails to correct the deficiencies noted above in Borrero. Accordingly, claim 6 is patentable under 35 U.S.C. 103(a) over Borrero in view of Yamada for at least this first reason.

Moreover, Borrero and Yamada fail to provide any motivation to substitute Yamada's slidable lid for Borrero's pivoting lid 46. The motivation asserted by the Final Action is "for the purpose of covering and uncovering the tissue dispensing opening." However, Borrero's pivoting lid 46 already satisfies the alleged motivation "of covering and uncovering the tissue dispensing opening." Therefore, the only motivation is Applicants' disclosure.

Applicants therefore respectfully submit that claim 6 is patentable under 35 U.S.C. § 103(a) over Borrero in view of Yamada.

For the reasons explained below, applicants respectfully traverse the rejection of claim 9 under 35 U.S.C. 103(a) as being unpatentable over Borrero in view of Pehr.

Pehr fails to correct the deficiencies noted above in Borrero. Accordingly, claim 9 is patentable under 35 U.S.C. 103(a) over Borrero in view of Pehr for at least this reason. Applicants therefore respectfully submit that claim 9 is patentable under 35 U.S.C. § 103(a) over Borrero in view of Pehr.

For the reasons explained below, applicants respectfully traverse the rejection of claim 10 under 35 U.S.C. 103(a) as being unpatentable over Borrero in view of Pehr and further in view of Amundson et al.

Amundson et al discloses a reclosable plastic bag and fails to correct the deficiencies noted above in Borrero. Accordingly, claim 10 is patentable under 35

U.S.C. 103(a) over Borrero in view of Pehr and further in view of Amundson et al for at least this first reason.

Moreover, Borrero, Pehr and Amundson et al fail to provide any motivation to substitute Amundson et al's translucent elastic material for Pehr's elastic material. The offered motivation of providing an indication of the quantity of wipes remaining in the package is superfluous in view of the explanation provided on page 7, lines 12 - 14 of the Final Office Action. There the Final Office Action already contends that Borrero's viewing window (32 and 34) allows the user to ascertain the contents of the body 10 without opening the lid. Thus, the only motivation to substitute Amundson et al's translucent elastic material for Pehr's elastic material is Applicants' disclosure.

Applicants therefore respectfully submit that claim 10 is patentable under 35 U.S.C. § 103(a) over Borrero in view of Pehr and further in view of Amundson et al.

For the reasons explained below, applicants respectfully traverse the rejection of claims 14, 15, 20, 21, 23, 24 and 27-30 under 35 U.S.C. 103(a) as being unpatentable over Borrero in view of Peebles.

Peebles fails to correct the deficiencies noted above in Borrero. Accordingly, claims 14, 15, 20, 21, 23, 24 and 27-30 are patentable under 35 U.S.C. 103(a) over Borrero in view of Peebles for at least this reason.

Claim 14 requires "a biasing structure configured with said body and disposed to bias said stacked absorbent articles generally away from said opening and towards said push structure." Admitting that Borrero lacks such a structure, the Final Action contends that:

Peebles discloses a biasing structure (21) configured with said body and disposed to bias said stacked absorbent

articles generally away from said opening and towards said push structure for the purpose of preventing the entire box from rising (see column 2 lines 67-72). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Borrero by including a biasing structure configured with said body to bias said stacked absorbent articles generally away from said opening and towards said push structure, as disclosed by Peebles, for the purpose of preventing the entire box from rising.

Thus, the Final Action contends that the person of ordinary skill would introduce the Peebles biasing structure (21) to bias the Borrero stacked absorbent articles (12) away from the Borrero opening (48) and towards the Borrero push structure (32 and 42). However, such a Peebles biasing structure (21) of necessity acts in direct opposition to Borrero's manual push structure of lid 32 and spring 42. For Borrero's manual push structure (lid 32 and spring 42) pushes toward the opening while the Peebles biasing structure (top cover 21) pushes away from the opening and towards the push structure. Accordingly, the person of ordinary skill would view this arrangement as rendering the Borrero device inoperative.

Moreover, upon reviewing the Peebles biasing structure (21) shown in Peebles FIG. 5A and the Borrero stacked absorbent articles (12) in relation to the Borrero opening (48) and push structure (32, 42) shown in Borrero's Fig. 7, it becomes self-evident that the Final Action's conclusion lacks credibility. Peebles top cover 21 faces against the planar surface of the tissues. But it is the edges of the Borrero stacked absorbent articles (12) that face the Borrero opening (48). The Borrero push structure (32, 42) pushes the Borrero stacked absorbent articles (12) in a direction that is at a right angle to the plane of the Borrero opening (48). Yet the Peebles teaching regarding its top cover 21 is that it only biases in one orthogonal direction, not two

directions at right angles to each other as would be required to satisfy the claim 14 requirement of biasing said Borrero stacked absorbent articles (12) generally away from said Borrero opening (48) and towards said Borrero push structure (32, 42). Thus, the Peebles teaching regarding its top cover 21 fails to apply to the way that the Borrero stacked absorbent articles (12) are disposed relative to the Borrero opening (48) and said Borrero push structure (32, 42). Plainly, to attempt to do as the Final Action proposes is physically impossible, and thus the person of ordinary skill could not do so.

Applicants therefore respectfully submit that claims 14 and 15 are patentable under 35 U.S.C. § 103(a) over Borrero in view of Peebles for at least these additional reasons.

As to claim 15, Borrero's detent 36 and 40 fails to constitute a biasing structure configured with the body to bias the stacked absorbent articles 12 generally away from the opening 48 and towards the push structure 32 and 42. Applicants therefore respectfully submit that claim 15 is patentable under 35 U.S.C. § 103(a) over Borrero in view of Peebles for at least this additional reason.

As to claim 20, the Peebles top cover 21 fails to constitute a biasing structure configured with the body and disposed to bias the stack of absorbent articles 12 towards Borrero's back wall 30.

In the third bullet point on page 12 of the Final Office Action, it is contended that Borrero discloses:

a manual push structure (32 and 42) defined in said back wall (30) and configured to allow a user to push on the bottommost one of said stacked absorbent articles (12) so as to move the uppermost one of said stacked absorbent articles (12) towards said opening (48) for grasping and

retrieval by the user in a direction generally transverse to a plane of said front wall (22)

However, taking the Final Action's designation of the manual push structure as Borrero elements 32 and 42, then this statement inaccurately describes what is disclosed by Borrero. As already explained above, under no reasonable interpretation can the Borrero top lid 32 or the Borrero spring 42 be said to be "defined in said back wall (30)." Per Borrero Fig. 7, Borrero top lid 32 is connected to Borrero back wall 30 by a hinge 34, and Borrero spring 42 is connected to Borrero top lid 32.

Moreover, claim 20 requires "a biasing structure configured with said body and disposed to bias said stack of absorbent articles towards said back wall." As is apparent in Borrero's Fig. 7, Borrero lacks any sort of biasing structure configured with said body and disposed to bias said stack of absorbent articles (12) towards said back wall (30).

The Final Action contends at page 12, lines 13-20 that:

Peebles discloses a biasing structure (21) configured with said body and disposed to bias said stack of absorbent articles towards said back wall for the purpose of preventing the entire box from rising (see column 2 lines 67-72). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Borrero by including a biasing structure configured with said body and disposed to bias said stack of absorbent articles towards said back wall, as disclosed by Peebles, for the purpose of preventing the entire box from rising.

Thus, the Final Action contends that the person of ordinary skill would introduce the Peebles biasing structure (21) to bias the Borrero stacked absorbent articles (12) towards the Borrero back wall (30). However, upon reviewing the Peebles biasing structure (21) shown in Peebles FIG. 5A and the Borrero stacked absorbent articles

(12) and the Borrero back wall (30) shown in Borrero's Fig. 7, it becomes self-evident that the Final Action's conclusion lacks credibility. Peebles top cover 21 faces against the planar surface of the tissues. But it is the edges of the Borrero stacked absorbent articles (12) that face the Borrero back wall (30). The planar surfaces of the Borrero stacked absorbent articles (12) do not face the Borrero back wall (30). Thus, the Peebles teaching regarding its top cover 21 fails to apply to the way that the Borrero stacked absorbent articles (12) are disposed relative to the Borrero back wall (30). Plainly, to attempt to do so would damage the Borrero stacked absorbent articles (12), and thus the person of ordinary skill would not do so.

Claim 24 requires an "access opening having a restricted size so as to prevent removal of said bottommost article through said access opening." As to claim 24, page 13, lines 4-7 of the final Office Action contends that:

Regarding claim 24, Borrero discloses the absorbent article carrying case as in claim 20, wherein said push structure comprises an access opening defined through said back wall, said access opening having a restricted size so as to prevent removal of said bottommost article through said access opening.

However, claim 24 calls for the size of the opening to be restricted, not obstructed or closed. Restricted is different from having the opening closed wherein there is no opening.

As to claim 24, Borrero fails to disclose an access opening having a restricted size so as to prevent removal of said bottommost article through said access opening. When the Borrero lid 32 is opened, that opening is where the articles are loaded into the housing and thus that opening fails to prevent removal of the bottommost article through the access opening. For the Final Action to take the position that the closed lid

satisfies the claim 24 limitation of “said access opening having a restricted size so as to prevent removal of said bottommost article through said access opening” is a position at odds with the plain meaning of the words to the person of ordinary skill. If the lid is closed, a closed lid does not restrict the size of the opening. There must be an opening for the opening to have size. A closed lid eliminates the opening. Opening and closing the lid does not affect the size of the opening. Opening and closing the lid affects the user’s access to the opening, whatever the opening’s size.

Moreover, the Final Action’s citation of Borrero in this manner necessitates turning the ordinary notions of upper and lower on their head. To the person of ordinary skill, and to human beings in general, notions of uppermost and bottommost are tied to the direction of the force of gravity. The Borrero opening 48 is intended in use to be lower than the Borrero top lid 32.

Applicants therefore respectfully submit that claims 14, 15, 20, 21, 23, 24 and 27-30, as presented herein, are patentable under 35 U.S.C. § 103(a) over Borrero in view of Peebles.

For the reasons explained below, applicants respectfully traverse the rejection of claim 22 under 35 U.S.C. 103(a) as being unpatentable over Borrero in view of Peebles and further in view of Yamada.

As noted above, neither Peebles nor Yamada corrects the deficiencies noted above in Borrero. Moreover, Peebles fails to overcome the deficiencies in the Borrero/Yamada combination noted above, and Yamada fails to overcome the deficiencies noted above in the Borrero/Peebles combination. Accordingly, claim 22 is

patentable under 35 U.S.C. 103(a) over Borrero in view of Peebles and further in view of Yamada for these reasons.

Moreover, Borrero and Yamada fail to provide any motivation to substitute Yamada's slidable lid for Borrero's pivoting lid 46. The motivation asserted by the Final Action is "for the purpose of covering and uncovering the tissue dispensing opening." However, Borrero's pivoting lid 46 already satisfies the alleged motivation of covering and uncovering the tissue dispensing opening." Therefore, the only motivation is Applicants' disclosure.

Applicants therefore respectfully submit that claim 22 is patentable under 35 U.S.C. § 103(a) over Borrero in view of Peebles and further in view of Yamada for this additional reason.

For the reasons explained below, applicants respectfully traverse the rejection of claim 25 under 35 U.S.C. 103(a) as being unpatentable over Borrero in view of Peebles and further in view of Pehr.

As noted above, neither Peebles nor Pehr corrects the deficiencies noted above in Borrero. Moreover, Peebles fails to overcome the deficiencies in the Borrero/Pehr combination noted above, and Pehr fails to overcome the deficiencies in the Borrero/Peebles combination noted above. Applicants therefore respectfully submit that claim 25 is patentable under 35 U.S.C. § 103(a) over Borrero in view of Peebles and further in view of Pehr.

For the reasons explained below, applicants respectfully traverse the rejection of claim 26 under 35 U.S.C. 103(a) as being unpatentable over Borrero in view of Peebles and Pehr as applied to claim 25, and further in view of Amundson et al.

As noted above, neither Peebles nor Pehr nor Amundson et al corrects the deficiencies noted above in Borrero. Moreover, neither Peebles nor Amundson et al overcomes the deficiencies in the Borrero/Pehr combination noted above. Neither Amundson et al nor Pehr overcomes the deficiencies in the Borrero/Peebles combination noted above. Neither Peebles nor Pehr overcomes the deficiencies in the Borrero/Amundson et al combination noted above. Applicants therefore respectfully submit that claim 26, as presented herein, is patentable under 35 U.S.C. § 103(a) over Borrero in view of Peebles and Pehr and further in view of Amundson et al for at least this first reason.

Moreover, Borrero, Peebles, Pehr and Amundson et al fail to provide any motivation to substitute Amundson et al's translucent elastic material for Pehr's elastic material. The offered motivation of providing an indication of the quantity of wipes remaining in the package is superfluous in view of the explanation provided on page 7, lines 12 - 14 of the Final Office Action. There the Final Office Action already contends that Borrero's viewing window (32 and 34) allows the user to ascertain the contents of the body 10 without opening the lid. Thus, the only motivation to substitute Amundson et al's translucent elastic material for Pehr's elastic material is Applicants' disclosure. Applicants therefore respectfully submit that claim 26 is patentable under 35 U.S.C. § 103(a) over Borrero in view of Peebles and Pehr and further in view of Amundson et al for this additional reason.

For the reasons explained below, applicants respectfully traverse the rejection of claim 31 under 35 U.S.C. 103(a) as being unpatentable over Peebles in view of Borrero.

Claim 31 depends on claim 20, and Peebles fails to correct the deficiencies noted above in Borrero as regards the rejection of claim 20. Applicants therefore respectfully submit that claim 31, as presented herein, is patentable under 35 U.S.C. § 103(a) over Peebles in view of Borrero.

In the Response to Arguments section on page 2 of the Final Action, the In re Lindberg decision is cited for the proposition that: "Providing portability to a prior art device is a design consideration within the skill of the art." However, attributing such a broad holding to the Lindberg decision is unwarranted. For what the Lindberg decision actually said was that (emphasis added):

it is not regarded as inventive to merely make an old device portable or movable without producing any new and **unexpected result**.

93 USPQ at 26. The "unexpected result" line of reasoning in the Lindberg decision rendered in 1952 was rebuked by the Supreme Court's 1966 decision in Graham v. John Deere, 383 U.S. 1 (1966), which may explain why Lindberg never has been cited in any published Federal Circuit opinion and why Lindberg never again was cited by the CCPA for this proposition after 1956. Even the Board of Appeals stopped citing Lindberg for this "unexpected result" line of reasoning after 1959. In fact, the Lindberg decision never has been cited for any proposition in any published opinion since 1964.

Moreover, lines 5-8 of paragraph 1 on page 2 of the Final Action assert that:

a recitation with respect to the manner in which an apparatus is intended to be employed does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim.

However, this assertion does not apply to applicants' claims. For applicants' claims

require a particular configuration. Moreover, that configuration clearly is not present in the prior art being cited against applicants' claims.

Page 3, lines 19-21 of the Final Office Action contends that:

simply that there are differences between the two references is insufficient to establish that such references "teach away" from any combination thereof. In re Beattie, 974 F.2d 1309, 1312-13, 24 U.S.P.Q. 2d 1040, 1042 (Fed. Cir. 1992).

However, Applicants' response pointed out why the differences in the references would make it unlikely that persons of ordinary skill would selectively extract certain features from the references in combination with other isolated features of the references. The differences were raised in order to highlight the fact that the Office Action was being selective in choosing features from each reference and combining them in a way that only was suggested by applicants' disclosure. The Final Office Action has not explained why persons of ordinary skill would selectively extract certain features from the references in combination with other features of the references, when those references contain teachings that work at cross-purposes from each other.

Applicants respectfully request reconsideration and reexamination of claims 1-18 and 20-32, as presented herein, and submit that these claims are in condition for allowance and should be passed to issue.

If any fee or extension of time is required to obtain entry of this Amendment, the undersigned hereby petitions the Commissioner to grant any necessary time extension and authorizes charging Deposit Account No. 04-1403 for any such fee not submitted herewith.

Respectfully submitted,

DORITY & MANNING, P.A.

DATE: 01/15/07

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